In the Supreme Court
OF THE
United States

OCTOBER TERM, 1951

No. 774

OXNARD CANNERS, INC., a corporation, and JAMES L. SMITH,
Petitioners,

vs.

THOMAS H. BRADLEY,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

SUMMARY STATEMENT.

The decision of the Court of Appeals for the Ninth Circuit sought to be reviewed on writ of certiorari was rendered in a patent infringement action. The action was ordinary in all respects in that the issues joined were the usual ones of invalidity of the patent on the grounds

that it lacked invention and was anticipated by prior art, and that the defendant's machine did not infringe the same. The action was one at law and tried before a jury. There were no exceptions taken to the Court's instructions to the jury by either side, and the jury rendered a verdict in favor of the plaintiff, finding the patent valid and infringed and awarding the plaintiff a reasonable royalty of Two Hundred Seventy Dollars and Fifty-nine Cents ($270.59) against one defendant and nominal damages of Ten Dollars ($10.00) against the second defendant.

Upon the filing of the verdict of the jury, defendant presented a motion (R. 19) for judgment notwithstanding the verdict or for a new trial, which was reviewed and denied by the District Court (R. 254). Thereupon in due course an appeal was filed to the Court of Appeals for the Ninth Circuit, alleging (in substance) as error that the patent was invalid as a matter of law in that it disclosed no patentable invention, and that the verdict of validity was contrary to the evidence. Also urged as error was that there was no infringement as a matter of law, and that the verdict of infringement was contrary to the evidence (R. 259).

The Court of Appeals for the Ninth Circuit, after a review of the entire record, affirmed the judgment and from its opinion (R. 270-280) it is clear that the Court of Appeals compared the patented device with the prior art relied upon in defense, and was convinced as a matter of fact and law that the patent disclosed a real, substantial and patentable invention.

It is also clear from the opinion that the Court of Appeals measured the patented machine against the accused machine and was convinced that infringement was clearly proven in that the patented and accused machines were substantially the same in construction, mode of operation, and produced the same result by substantially the same means and mode of operation.

ARGUMENT.

THERE IS NO SPECIAL OR IMPORTANT REASON FOR GRANTING THE PETITION FOR WRIT OF CERTIORARI.

We appreciate that a review on writ of certiorari rests in the sound judicial discretion of this Court, but this Court has always held that such a writ will be granted only where there are special and important reasons therefor. We urge that no such reasons are here presented.

(1) In the instant matter the decision of the Court of Appeals sought to be reviewed is not in conflict with the decisions of another Court of Appeals on the same matter.

(2) Petitioners state as a reason for granting the writ that there is probable absence of conflict in other circuits. This is not based on the record and is not true in fact because the petition itself on page 9 states that only a limited number of the machines were used "only in the Ninth Circuit and in foreign countries". There is a complete absence of any testimony or other evidence showing this to be the fact. These machines are for use in eviscerating Monterey sardines (about herring size), which are relatively large fish, and the same machine is

used for eviscerating mackerel and the large type of anchovies, as well as herring. These fish, as the Court may take judicial notice of, abound in the coastal waters of many countries, including both coasts of the United States. Consequently, there is no basis in the record or in fact for petitioners' statement in the petition that there is "a probable absence of conflict in other circuits". The fact that the machines are relatively new and are built locally in California by the petitioners would be one reason that they were not in use (if such is the case) along the Atlantic coast as well as along the Pacific coast.

(3) As a second reason for granting the writ, petitioners urge that the Court departed from the usual course or practice in patent cases. We urge that there is no basis for such contention. The District Court, in considering the motion for a directed verdict as well as the motion for a judgment notwithstanding the verdict and for a new trial, considered the question of validity of the patent and the question of infringement and denied such motions. This is clear from the District Judge's statement, "it did appear that there was a contribution by the plaintiff from the claims of his patent of a combination nature that did give a plausible ground for the issuance of the patent—and I think that could be seen by the jury just as well as it could be by the Court—".

As to the question of infringement raised by such motions, the District Court held, "As to the question of infringement, I am satisfied that there isn't any question about the correctness of the jury's verdict."

The Court of Appeals, in reviewing the question of invalidity raised by the appeal, diligently measured the patented machine as against the prior art, as is evident from the following in its opinion (R. 270-280), and concluded that it was a patentable invention:

> "We therefore look at the evidence on the issues of validity and infringement. Uncontradicted testimony of appellee Bradley shows that prior to 1944, (the year that Bradley's machine was first installed in a plant) eviscerating devices then used did not meet state requirements. Hand inspection of each fish was then necessary. This inspection precluded the use of any mechanical packing machine. When, in 1944, appellee produced a machine embodying his invention and placed the same in operation in a Monterey cannery, it not only removed at least 95% of the fish viscera, but did so at the rate of 180 fish per minute, thus enabling the fish to be mechanically packed into cans. That the production of such a machine as appellee's was a boon to the industry is clearly indicated by the testimony of Joseph Benossi, the superintendent of a fish packing company not involved in this litigation.
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> * * * * *
>
> It is also undisputed that without such an efficient eviscerating machine mechanical packing machines are valueless and of no practical use in the industry."

The Court of Appeals also concluded that the patented machine was a new combination of elements having a new mode of operation, and which produced a new or improved result, and properly applied the law to these findings as follows:

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"Aside from that, it is well settled that a combination of old elements which form a machine having a new modus operandi and which produces a new or improved result is patentable. R.S. §4886, 35 U.S.C. §31; Cantrell v. Wallick, 117 U. S. 689, 1886. 'With respect to the result produced, it is not essential that it be a wholly new result, but it is sufficient if an old result is effected in a more facile, economical, or efficient way.' Independent Oil Well Cementing Co. v. Halliburton, 54 F.2d 900, 905, 10-Cir., 1932, cert. denied, 286 U.S. 544, and cases cited therein. See also Levin v. Coe, 132 F.2d 589, 596, C.A.D.C., 1942; Application of Barrett, 182 F.2d 626, 630, C.C. P.A., 1950."

Thus, it is evident that contrary to the petitioners' statement there was no departure from the usual practice in patent cases or in the standards of law determining invention in the decision by the Court of Appeals for the Ninth Circuit in the instant case.

(4) The Court of Appeals' decision is not in conflict with the decisions of this Court. There is no conflict between the decision of the Court of Appeals in the instant case and the applicable decisions of this Court. In the case of *Faulkner v. Gibbs* (9 Cir. 1948), 170 F. 2d 30, 34, this Court held that under certain circumstances the question of validity (when applied to the matter of invention) and the question of infringement were questions of fact. This case is not in conflict with the case of *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 95 L.Ed. 162, wherein this Court decided that the Courts should in proper cases consider

the question of patentable invention as a matter of law to make certain that the invention met the constitutional standards of patentability. This was done by the District Court in denying the motion for directed verdict and also by the Court of Appeals for the Ninth Circuit, as is evident from its opinion, in concluding patentability from the substantiated facts that the patented machine accomplished something entirely new in the industry and was a boon to the industry, and that it was a new combination of elements producing a new or improved result, as previously set forth. That Court also concluded that the patented machine was patentably novel from its review of the evidence on the factual question as to whether or not the patented and prior machines were similarly constructed and had a similar mode of operation, and produced similar results. On this question the Court of Appeals opined:

> "* * * Both appellee Bradley and witness Benossi testified that the operation of appellee's device was not, in any fashion, akin to that shown in prior art devices referred to as Gray, Kurzbin, and Abbott. Nor was the construction anywhere comparable. As to a McGrew patent, contended by appellant to have anticipated appellee's invention, the only evidence on the subject was elicited from Smith. And such evidence, from this appellant himself, establishes that the McGrew machine is totally unlike the Bradley (or Smith) machine in mode of operation, construction, and result."

(5) There is no question but that the judgment which was sustained by the Court of Appeals was supported by

substantial evidence on the questions of invention, validity and infringement. The Court of Appeals, after reviewing the evidence (as is evident from its opinion (R. 270-280), found that the judgment as to these three issues was not only supported by substantial evidence, but in some instances the only evidence.

CONCLUSION.

We submit—

(1) That there is no special or important reason for granting the petition for writ of certiorari.

(2) That there was no error in the decision of the Court of Appeals for the Ninth Circuit sought to be reviewed.

(3) That the law applied by the Court of Appeals for the Ninth Circuit in reaching its decision is not in conflict with any applicable decision of this Court or any other Court of Appeals.

Therefore, we respectfully submit that the petition for writ of certiorari should be denied.

Dated, San Francisco, California,
May 23, 1952.

Respectfully submitted,
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October Term, 1951
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PETITIONERS' REPLY BRIEF

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